

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Michael Chiviendacz et al. Examiner: Fikremariam A. Yalew

Serial No.: 10/748,523

Art Unit: 2436

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Docket No.: 10500.03.0716

Confirmation No.: 8541

Title: **METHOD AND APPARATUS FOR SECURELY PROVIDING IDENTIFICATION INFORMATION USING TRANSLUCENT IDENTIFICATION MEMBER**

REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicants respectfully submit that the Examiner's rejections include clear error.

Claims 52-56 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicants respectfully submit that there has been clear error since the claim language has been misapprehended and an improper basis has been provided for rejecting these claims.

Claim 52 reads:

52. A transaction card comprising:
a first portion at least containing transaction card account information; and
a second portion containing a translucent identification member having a translucent area that includes one or more obscured user identifiers.

A "transaction card" is being claimed, yet the office action rejects the claim alleging that "claim 52 is an apparatus claim without any structural component and consists solely of language that is implemented with only software" (final action, page 4). In their response to the non-final action, Applicants requested that the definition of a transaction card being used by the Patent Office to reject the claim be provided (see page 14 of Applicants' Remarks). However, no definition has been provided.

Applicants respectfully submit that the claim is not claiming software of any kind and that the claims are not being reasonably interpreted in view of the Specification. By way of example, the claim requires that a transaction card contains not only certain indicia such as

transaction card account information, but also requires a second portion containing “a translucent identification member”.

With respect to paragraph 0055 of Applicants’ Specification, examples are provided of transaction cards that employ translucent identification members and it is stated that the transaction cards may be, for example, smart cards or non-smart cards and have conventional information associated with debit cards, credit cards or any suitable transaction cards and in addition include a translucent identification member 14. Applicants also respectfully submit that Applicants’ Specification, paragraph 0038 and elsewhere, indicate that the translucent identification member may be made of any suitable material such as plastic and may be, for example, a sheet, film or other member (see paragraph 0039 of Applicants’ Specification). Applicants respectfully submit that the claims are properly directed to an apparatus and in particular, a transaction card which is a product of manufacture. Accordingly, Applicants respectfully submit that there has been clear error and the Examiner’s rejection must be withdrawn.

Additional clear error is also present in other rejections. For example, Claims 1-4, 22-23 and 25-27 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Goede in view of Ginter et al. The rejection cites to Goede, namely col. 1, lns. 44-47 and col. 2, lns. 45-47. Applicants again respectfully submit that these cited portions make no reference whatsoever to any identification information that identifies a plurality of obscured user identifiers or providing such identification information on the translucent identification member. The reference in Goede referring to “sequence representing means locatable by the location designating means for representing a predetermined sequence” actually refers to a “personal identification number” associated with the user that the user may have set up in advance. This is different information from identification information that identifies the plurality of obscured user

identifiers. The obscured identifiers in Goede have no identification information assigned to them. A subset of the obscured identifiers form the sequence described in Goede. Accordingly, Applicants respectfully submit that the Goede reference does not teach what is alleged and therefore the claims should be passed to allowance. Applicants respectfully reassert the remarks made in the previous office action.

Claims 11-20 and 29-51 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Oksman et al. in view of Goede. Applicants respectfully submit that the Oksman reference actually teaches the opposite of what is claimed. For example, as set forth in claim 11 the “visual filtering pattern” is sent to the display device whereas the “obscured user identifiers” are “located on a translucent identification member sized to be smaller than the display”. As such, the obscured user identifiers are not displayed on a display. To the contrary, the visual filtering pattern is sent to the display device. In contrast, the cited portions of Oksman state that the “characters, icon, pictures, words or other graphic representations” are actually presented on “video display 7” (col. 4, lns. 13-26). The removable screen 13 actually serves as a type of visual filtering pattern in Oksman. As such, a completely opposite approach is described in Oksman wherein the characters or icons are displayed on the display and the screen 13 is used as a type of filter. Oksman actually teaches that the visual filter is actually “removable screen 13”. The removable screen has no obscured user identifiers located thereon nor would the system of Oksman work if it was combined with Goede because they operate in opposing manners. Applicants respectfully submit that the Oksman reference does not teach what the Examiner alleges as the basis for the rejection of the claims and as such, there has been clear error.

Claims 6-9 and 52-56 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Goede. The office action recites to Goede, namely col. 2, lns. 45-47 and col. 1,

Ins. 58-61. However, these cited portions are silent as to any transaction card account information. Instead, the cited portions merely state that the substrate of Goede may be transparent. Goede does not teach what is alleged in the cited portion. Accordingly, Applicants respectfully submit that there has been clear error as to claims 52-56.

As to claims 6-9, Applicants respectfully submit that a transaction card is created by an apparatus wherein the apparatus provides the identification information for placement on the translucent identification member and the identification information is assigned to the one or more obscured user identifiers. As noted above with respect to claim 1 for example, Goede does not contemplate any such information being placed on any translucent identification member. Accordingly, Applicants respectfully submit that there has been clear error with respect to these claims as well.

In view of the preceding discussion, reconsideration and withdrawal of the rejection of the claims is respectfully requested and a Notice of Allowance is respectfully requested.

Respectfully submitted,

Dated: July 18, 2011

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